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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of:

Yoshihiko Shioda)	
Serial No.: 09/444,120 ✓)	Examiner: RaeAnn Gorden
Filed: November 19, 1999)	
For: GOLF PRACTICE AND)	Art Unit: 3711
EXERCISE DEVICE)	

Charlotte, North Carolina July 3, 2003

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RESPONSE

This is in response to the Final Action dated May 23, 2003, in which Claims 1, 18-20 and 23 are rejected on the basis of the single prior art reference, Davis U.S. Patent No. 3,168,312 under both 35 U.S.C. § 102 and 35 U.S.C. § 103.

This latest rejection on the single Davis reference, that was not cited until more than three years after the filing date of the application and after an Appeal Brief had been filed, is respectfully traversed.

The Examiner admits in the Final Action that the Davis patent does not teach utilizing a ball of a weight and size for one sport (Claim 1: said object having a golf clubhead impact surface of a size at least that of the corresponding surface of a softball), but asserts that this distinction is related to a method of use, not apparatus, and that applicant is not entitled to a patent for an apparatus with identical structural features as the prior art with a different method of use.

Applicant respectfully points out that Claim 1 contains structural limitations recited in relation to a golf club that distinguishes the claims from the Davis patent and that these distinctions are structural, not method distinctions.

In particular, Claim 1 recites "an object swingably suspended from said mounting arm with at least a portion of said object adjacent the floor or ground in position to be struck by a golf clubhead during a normal swing of a golf club. This is a structural limitation defining the position of the object. While it is a position relating to a golf clubhead, it none the less is a structural limitation of the position of the object in relation to the ground.

Claim 1 further states that "said object being of a mass at least that of a softball to provide substantial resistance to the impact of a golf club to impose muscular strain on the golfer for muscle development but being limited in mass to allow the head of a golf club to swing the object sufficiently for the golf clubhead to ultimately pass under the object and allow the golfer to complete the follow through of the golf swing." Hereagain, the structure is recited as being of a particular mass. While it is defined in terms of the amount of resistance it would impose to a golf club, it is none the less a structural limitation. While use with a golf club is recited in the claim, it is recited in terms of defining the structure, i.e., the mass of the object.

Furthermore, the swingable mounting of the object and the mass provide a structure that imposes muscular strain on the golfer and that, when swung in response to being hit by a golf clubhead, will be of such structure as to allow the golf clubhead to ultimately pass under the object as the object swings on its mounting.

None of this is disclosed or suggested in Davis. No soccer ball size object is taught or suggested by Davis as Davis teaches the use of balls of sizes normally used to strike that size ball with an implement, such as a baseball bat or a golf club. A soccer ball is not used to be struck by

an implement. Davis does disclose use of the device with a golf ball attached to the end of a retrieving line, where the golf ball rests on the ground with a length of the retrieving line lying on the ground, rather than the ball being suspended, as claimed in Claim 1 of the present application. Further, the ball is not swingably mounted in a structural arrangement where a golf clubhead would pass under the ball due to the swingable mounting as claimed. Rather, Davis discloses the attachment of the golf ball to a retrieving line that allows the golf ball to travel in a normal trajectory until stopped by the limit of the mechanism that responds to retrieve the ball. There is no swingable mounting and no structure that would result in a golf clubhead passing under the ball as claimed in Claim 1 of the present application.

For the foregoing reasons, it is respectfully submitted that Claim 1 and dependent Claims 18-20 are allowable.

Independent Claim 23 similarly recites structure as it recites that the object is secured to and extends between the mounting arm and the base in position for striking by a golf clubhead during a normal golf swing and stopping the golf clubhead in an impact position. This is not simply a recitation of method, but a recitation of the structure of the object and its securement in that it is secured and it is of a mass that stops a golf clubhead. This is a structural limitation not disclosed in Davis, which teaches a golf ball attached to a retrieving line in a structure that could not stop anything, but rather is intended to be projected when struck. Thus, it is submitted that Claim 23 is similarly allowable.

Reconsideration of the rejection in the Final Action is respectfully requested.

Respectfully submitted,



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